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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,252	09/21/2005	Riki Okamoto	52433/818	1945
26646 7590 08/26/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER YEE, DEBORAH				
ART UNIT 1793		PAPER NUMBER		
MAIL DATE 08/26/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/550,252

**Applicant(s)**

OKAMOTO ET AL.

**Examiner**

Deborah Yee

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 6 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 2 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 2001-342543 ("JP-543") alone or in view of US Patent No. 5,470,529 to Normura ("US-529") for the reasons set forth in previous office action dated February 13, 2009.

***Response to Arguments***

3. Applicant's arguments filed June 12, 2009 have been fully considered but they are not persuasive with respect to claims 1 and 2 rejected under 35 U.S.C. 103 as being unpatentable over Japanese patent 2001-342543 ("JP-543") alone or in view of U.S. Patent No. 5,470,529 to Normura et al. ("US-529").
4. Applicant submitted that hot rolled steel sheet of present invention has a ferritic structure which exhibits excellent hole expandability, ductility, and tensile strength  $\geq 980 \text{ N/mm}^2$  without containing Mg. In contrast, the steel of JP-543 has bainite in its structure and requires Mg  $\geq 0.0005\%$  which functions to make the size of Ti and/or Nb carbides small (paragraph 0025) to improve hole expandability and ductility (paragraph 0023).

5. In response to argument, it is the Examiner's position that English abstract of JP-543 teaches steel having a structure mainly ferrite with residual bainite which would meet the "ferritic structure" of the present invention since Applicant's limitation does not recite 100% ferrite or exclude additional phases, such as small amounts of bainite.

6. In addition, even though steel of JP-543 contains 0.0005 to 0.01% Mg and is excluded by "consisting of" recited in Applicant's claims, such difference would not be a patentable distinction. According to third paragraph on page 7 of Applicant's specification and paragraph [0023] of JP-543, both teach adding at least 0.0005% Mg to steel alloy for the same purpose which is to combine with oxygen to form very fine and evenly distributed Mg oxides and composite Mg oxides with  $Al_2O_3$ ,  $SiO_2$ ,  $MnO$  and  $Ti_2O_3$  resulting in the suppression stress concentration and coarse cracking thus improving hole expandability. For Applicant to amend claim to exclude Mg would merely depict the omission of an element (Mg ) with the consequent loss of its known function, and therefore would not be of any patentable significance, see *In re Wilson et al.*, 153USPQ740. This is evident base on Applicant's test data in tables 1 to 4 of instant specification wherein steel examples T to Z containing Mg have much high hole expansion compared to examples A to S without Mg.

7. Applicant's arguments filed June 12, 2009, with respect to claims 1 and 2 rejected under 35U.S.C. 103 as being unpatentable over US Patent No. 6,364,968 to Yashuhara et al alone or in view of U.S. Patent No. 5,470,529 to Normura et al. have been fully considered and are persuasive. The newly amended claims recite a steel sheet having ferritic structure whereas US'968 teaches a steel having mainly a bainitic

structure without ferrite as evident by Table 5 in columns 19-20 and lines 25 to 37 in column 8. Hence the Rejection has been withdrawn.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/  
Primary Examiner  
Art Unit 1793

/DY/